

The opinion in support of the decision being entered today was **not** written for publication in a law journal and is **not** binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOHN W. VON HOLDT

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Appeal No. 1997-4013  
Application No. 08/145,867

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ON BRIEF

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Before ABRAMS, STAAB, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 26 to 33 and 38 to 40, as amended subsequent to the final rejection. Claims 1 to 9 and 12 to 24 have been allowed. Claims 34 to 37 have been objected to as depending from a non-allowed claim. Claims 10, 11 and 25 have been canceled.

We REVERSE.

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BACKGROUND

The appellant's invention relates to a mold for use in a molding press. A copy of the claims under appeal is set forth in the appendix to the appellant's reply brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

|   |                          |          |
|---|--------------------------|----------|
| Bruder<br>1975                            | 3,867,080                | Feb. 18, |
| Saumsiegle et al.<br>1978<br>(Saumsiegle) | 4,077,759                | March 7, |
| Teraoka <sup>1</sup><br>1986              | 61-163820<br><br>(Japan) | July 24, |

Claims 38 and 39 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bruder.

Claims 38 and 39 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Teraoka.

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<sup>1</sup> In determining the teachings of Teraoka, we will rely on the translation provided by the PTO. A copy of the translation is attached for the appellant's convenience.

Claims 26 to 33 and 40 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bruder in view of Saumsiegle.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 18, mailed May 13, 1997) for the examiner's complete reasoning in support of the rejections, and to the revised brief (Paper No. 17, filed February 10, 1997) and reply brief (Paper No. 19, filed July 17, 1997) for the appellant's arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

#### **The anticipation rejections**

We will not sustain the rejection of claims 38 and 39 under 35 U.S.C. § 102(b) as being anticipated by Bruder. Likewise, we will not sustain the rejection of claims 38 and 39 under 35 U.S.C. § 102(b) as being anticipated by Teraoka.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). In addition, it is well established that an anticipation rejection cannot be predicated on an ambiguous reference. Rather, statements and drawings in a reference relied on to prove anticipation must be so clear and explicit that those skilled in the art will have no difficulty

in ascertaining their meaning. See In re Turlay, 304 F.2d 893, 899, 134 USPQ 355, 360 (CCPA 1962).

With regard to claim 38, the appellant argues (revised brief, pp. 15-18; reply brief, pp. 6-7) that both Bruder and Teraoka lack the claimed leader pins (i.e., "a plurality of leader pins which extend through corresponding holes [in] each of said first, second and third plates for support of said first runner plate, said leader pins extending from said second mold core plate to said third mold core plate in a mold-open position"). The examiner's position with regard to the leader pins limitations of claim 38 is that these limitations are readable on<sup>2</sup> Bruder's guide pins 50 and Teraoka's tie-bars 1a.

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<sup>2</sup> The law of anticipation does not require that the reference teach what the appellant is claiming, but only that the claims on appeal "read on" something disclosed in the reference (see Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984)).

Bruder does not anticipate claim 38 since the claimed leader pins are not readable on Bruder's guide pins 50. In that regard, Bruder does not disclose that his guide pins 50 extend from the second mold core plate to the third mold core plate in the mold-open position. Likewise, Bruder does not disclose that his guide pins 50 **extend through** corresponding holes in each of the second and third plates for support of the first runner plate. While Figure 3 of Bruder does illustrate one of the guide pins 50, Bruder does not discuss the actual length of the guide pins 50. Thus, we cannot, with any degree of certainty, ascertain whether the leader pins as recited in claim 38 are readable on Bruder's guide pins. Under these circumstances we cannot agree with the examiner that Bruder anticipates the subject matter of claim 38.

Teraoka does not anticipate claim 38 since the claimed leader pins are not readable on Teraoka's tie-bars 1a. In that regard, Teraoka does not disclose that his tie-bars 1a **extend through** corresponding holes in each of the second and third plates for support of the first runner plate. While

Figures 1 and 2 of Teraoka do illustrate the tie-bars 1a, Teraoka does not discuss whether or not the tie-bars 1a **extend through** corresponding holes in the second and third plates (i.e., that the tie-bars **extend through** holes in the female molds 3). Thus, we cannot, with any degree of certainty, ascertain whether the leader pins as recited in claim 38 are reader on Teraoka's tie-bars 1a. Under these circumstances we cannot agree with the examiner that Teraoka anticipates the subject matter of claim 38.

For the reasons set forth above, the decision of the examiner to reject claim 38, and claim 39 which depends therefrom, under 35 U.S.C. § 102(b) is reversed.

#### **The obviousness rejection**

We will not sustain the rejection of claims 26 to 33 and 40 under 35 U.S.C. § 103. Upon evaluation of all the evidence before us (i.e., the applied prior art), it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness.



In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

In this case, we agree with the appellant's argument (revised brief, pp. 13-15 & 19; reply brief, pp. 4-6) that the applied prior art does not suggest the claimed subject matter.

All the claims subject to the rejection under 35 U.S.C. § 103 require the first, second and third plates be generally rectangular but having at least one projection as set forth in claim 26 or claim 40. While Saumsiegle does teach a plate

having the claimed shape, it is our view that Saumsiegle would  
not have

suggested modifying the plates of Bruder absent the use of hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claims 26 to 33 and 40 under 35 U.S.C. § 103 is reversed.

#### CONCLUSION

To summarize, the decision of the examiner to reject claims 38 and 39 under 35 U.S.C. § 102(b) is reversed and the

decision of the examiner to reject claims 26 to 33 and 40  
under 35 U.S.C. § 103 is reversed.

REVERSED

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|-----------------------------|---|-----------------|
| NEAL E. ABRAMS              | ) |                 |
| Administrative Patent Judge | ) |                 |
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|                             | ) | BOARD OF PATENT |
| LAWRENCE J. STAAB           | ) | APPEALS         |
| Administrative Patent Judge | ) | AND             |
|                             | ) | INTERFERENCES   |
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| JEFFREY V. NASE             | ) |                 |
| Administrative Patent Judge | ) |                 |

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ALLEGRETTI & WITCOFF, LTD.  
TEN SOUTH WACKER DRIVE  
CHICAGO, IL 60606

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